

Jun 07 05 02:12p SVIPG

PATENT & TRADEMARK OFFICE
DIVISION
408 971 4660



ZILKA-KOTAB

PC
ZILKA, KOTAB & FEECE™

95 SOUTH MARKET ST., SUITE 420
SAN JOSE, CA 95113

TELEPHONE (408) 971-2573
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FAX COVER SHEET

| | | |
|-------------------------------|--------------|----------------|
| Date: June 7, 2005 | Phone Number | Fax Number |
| To: Petitions Division, USPTO | | (703) 872-9306 |
| From: Dominic M. Kotab | | |

Docket No.: IBM1P008/SJ09-2001-0135US1

App. No: 09/938,457

Total Number of Pages Being Transmitted, Including Cover Sheet: 10

Message:

Please deliver to the Petitions Division.

Thank you,

Dominic M. Kotab

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☐ Original to follow Via Regular Mail ☒ Original will Not be Sent ☐ Original will follow Via Overnight Courier

06/10/2005 DALLEH 00000016 090466 09938457

01 FC:1464 130.00 DA

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AT (408) 971-2573 AT YOUR EARLIEST CONVENIENCE

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DIVISION

p. 2



Practitioner's Docket No. IBM1P008/SJ0920010135US1

2005 JUN -9 AM 9:30 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Robert G. Biskeborn

Application No.: 09/938,457

Filed: 08/23/2001

For: PIN ADAPTER FOR AIR BEARING SURFACE (ABS) LAPPING AND METHOD FOR USING THE SAME

Group No.: 11/04/2004

Examiner: Eley, Timothy V.

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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OFFICE OF PETITIONS

PETITION TO WITHDRAW HOLDING OF ABANDONMENT
— OFFICE ACTION NOT RECEIVED

1. In response to the Notice of Abandonment mailed 6/3/2005, I hereby petition to withdraw the holding of abandonment in this case, on the basis that the Office Action forming the basis of the abandonment was not received.
2. I hereby state:
 - (a) The Office Action indicated, as mailed on November 4, 2004, was not received.
 - (b) A search of the file jacket and the docket records in my office indicates that this Office Action was not received.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

— deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)

— with sufficient postage as first class mail.

37 C.F.R. § 1.10*

— as "Express Mail Post Office to Addressee"


Mailing Label No. _____ (mandatory)

TRANSMISSION

✓ — facsimile transmitted to the Patent and Trademark Office, (703) 872-9306.

Date:

6/7/2005



Signature

Erica L. Farlow

(type or print name of person certifying)

* Only the date of filing (1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under 1.8 continues to be taken into account in determining timeliness. See 1.703(f). Consider "Express Mail Post Office to Addressee" (1.10) or facsimile transmission (1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Petition to Withdraw Holding of Abandonment—Office Action Not Received—page 1 of 2

3. I attach a copy of the docket record where the non-received Office Action would have been entered had it been received and docketed. Please see page 2 of Exhibit A. This shows how the entry would have appeared on our docket.

4. As additional evidence of non-receipt of the Office Action, I also attach:

Exhibit B is a copy of the PAIRConnect Patent Record which shows a direct comparison of the PTO Action Items on the PAIR system and the IP Master Actions listed in our docketing database. The PAIR column shows the mailing of the Non-Final Rejection on 11/04/2004, but there is no action noted as received on our side.

5. In consideration of these submissions, it is respectfully requested that the holding of abandonment be withdrawn.

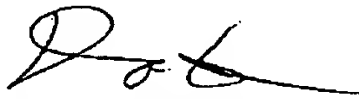
6. The petition fee (37 C.F.R. § 1.17(h)—\$130.00) is paid as follows:

Should the Commissioner find that a fee is necessary, authorization is hereby made to charge the amount of \$130.00 to Deposit Account No. 09-0466 (Order No. SJ0920010135US1).

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

Reg. No.: 42,762
Tel. No.: 408-971-2573
Customer No.: 50535



Signature of Practitioner
Dominic M. Kotab
Zilka-Kotab, PC
P.O. Box 721120
San Jose, CA 95172-1120
USA

Practitioner's Docket No. IBM1P008/SJ0920010135US1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Robert G. Biskeborn

Application No.: 09/938,457

Group No.: 11/04/2004

Filed: 08/23/2001

Examiner: Eley, Timothy V.

For: PIN ADAPTER FOR AIR BEARING SURFACE (ABS) LAPPING AND METHOD FOR USING THE SAME

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JUN 13 2005

OFFICE OF PETITIONS

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

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37 C.F.R. § 1.8(a)

— with sufficient postage as first class mail.

37 C.F.R. § 1.10*

— as "Express Mail Post Office to Addressee"

Mailing Label No. _____ (mandatory)

TRANSMISSION

✓ — facsimile transmitted to the Patent and Trademark Office, (703) 872-9306.

Date:

6/7/2005

Signature

Erica L. Farlow

(type or print name of person certifying)

* Only the date of filing (1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under 1.8 continues to be taken into account in determining timeliness. See 1.703(f). Consider "Express Mail Post Office to Addressee" (1.10) or facsimile transmission (1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Petition to Withdraw Holding of Abandonment—Office Action Not Received—page 1 of 2

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5. In consideration of these submissions, it is respectfully requested that the holding of abandonment be withdrawn.
6. The petition fee (37 C.F.R. § 1.17(h)–\$130.00) is paid as follows:

Should the Commissioner find that a fee is necessary, authorization is hereby made to charge the amount of \$130.00 to Deposit Account No. 09-0466 (Order No. SJ0920010135US1).

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.



Signature of Practitioner
Dominic M. Kotab
Zilka-Kotab, PC
P.O. Box 721120
San Jose, CA 95172-1120
USA

Reg. No.: 42,762
Tel. No.: 408-971-2573
Customer No.: 50535

Patent Case Print [ID 201]

Page 1 of 3

Exhibit A

Patent: IBM1P008, United States, Regular, National,
Original Filing

Patent Data

| | | | |
|---------------------|---------------------|---------------------|---------------------------------|
| Docket No | IBM1P008 | Senior Attorney | Dominic M. Kotab |
| Country | United States | Primary Attorney | |
| Case Type | Regular | Client/Division | International Business Machines |
| Relation Type | Original Filing | Current Owner | International Business Machines |
| Filing Type | National | Previous Owner | |
| Filing Number | | Client Case No. | SJ09-2001-0135US1 |
| Status | Filed | First Filing Date | 8/23/2001 |
| Sub Status | | Sub Status Date | |
| Parent Country | | Parent Filing Date | |
| Parent Number | | Parent Grant Date | |
| Application Number | 09/938,457 | Application Date | 8/23/2001 |
| Patent Number | | Grant Date | |
| Publication Number | 2003-0040257 | Publication Date | 2/27/2003 |
| Assigned | Assignment Recorded | Ind. Claims/Designs | 0 |
| Convention Type | No Foreign Filing | Total Claims | 0 |
| Req Not To Pub Incl | No | TotalClasses | |
| TaxAgent | | ConfirmationNumber | |
| Firm Attorney | | Tax Base Date | |
| Administrator | | Next Tax Date | |
| Custom Party #2 | | Expiration Date | |
| Custom Party #3 | | Custom Text #1 | |
| Custom Party #4 | | Custom Date #1 | |
| Custom Party #5 | | Alt Case No | |
| Custom Party #6 | | Priority Date | |
| Custom Party #7 | | US Case No | |
| Custom Party #8 | | Custom Date #3 | |
| Firm Case Number | | Custom Text #4 | |
| Custom Code #2 | | Custom Date #4 | |
| Custom Code #3 | | Text #5 | |
| Custom Code #4 | | Text #6 | |
| Custom Code #5 | | Text #7 | |
| Custom Code #6 | | Text #8 | |
| Custom Code #7 | | Confirm No | |
| Customer Code | | Customer Name | Silicon Valley IP Group |

Title

Pin Adapter For Air Bearing Surface (Abs) Lapping And Method For Using The Same

Description

Current Expense Information

Other Case-Related Information

Actions

| Action Code | Action Due Date | Taken Date | Deadline Date | Completed Date | Post Card Received | Who | Action Notes |
|------------------------------|-----------------|------------|---------------|----------------|--------------------|------------------|--|
| Recorded Assignment Received | | | | 2/28/2002 | | Dominic M. Kotab | To International Business Machines Corporation |

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Patent Case Print [ID 201]

Page 2 of 3

| | | | | | |
|----------------------------------|------------|------------|-----|----------|--|
| Office Action | | 9/10/2003 | | Dominic | |
| Mailed Date | | | | M. Kotab | |
| Office Action | | 1/29/2004 | | Dominic | |
| Mailed Date | | | | M. Kotab | |
| Office Action | | 4/13/2004 | | Dominic | |
| Mailed Date | | | | M. Kotab | |
| Filing Receipt | | 1/10/2002 | | Dominic | |
| | | | | M. Kotab | |
| Notice of | | 9/26/2001 | | Dominic | |
| missing parts | | | | M. Kotab | |
| mail d | | | | | |
| File Audit Date | | 10/26/2004 | | | |
| Notes | | 5/6/2005 | | | |
| | | | | | During an ongoing file audit, I found that PAIR showed a Restriction mailed on 11/4/2004. We never received this Restriction. The 6 month date was 5/4/2005. |
| → Restriction mail date | | 11/4/2004 | | Dominic | If Document had been received ← |
| | | | | M. Kotab | |
| Assignment | 10/23/2001 | 11/21/2001 | Yes | Dominic | (MDC Rule 5/7) |
| | | | | M. Kotab | |
| Information Disclosure Statement | 10/23/2001 | 8/30/2001 | Yes | Dominic | (MDC Rule 6/13a-b) |
| | | | | M. Kotab | |
| Filing Receipt | 11/23/2001 | 9/26/2001 | Yes | Dominic | (MDC Rule 2/52a-53a) |
| | | | | M. Kotab | |
| Notice of missing parts - final | 11/26/2001 | 11/21/2001 | Yes | Dominic | |
| | | | | M. Kotab | |
| Publication | 2/23/2003 | 2/27/2003 | | Dominic | (MDC Rule 2/98) |
| | | | | M. Kotab | |
| Status Inquiry | 8/23/2003 | 8/5/2003 | Yes | Dominic | Request for Status (MDC Rule 7/5a-7/13a) |
| | | | | M. Kotab | |
| Status Inquiry | 10/5/2003 | 8/19/2003 | | Dominic | This application will be examined in 0-3 months |
| | | | | M. Kotab | |
| Status OA? | 11/19/2003 | 9/10/2003 | | Dominic | |
| | | | | M. Kotab | |
| Office Action 3 mos. | 12/10/2003 | 11/19/2003 | Yes | Dominic | Response to Restriction Requirement |
| | | | | M. Kotab | |
| Response Due | 2/29/2004 | 2/23/2004 | | Dominic | OA DEADLINE - Shortened Statutory Period |
| | | | | M. Kotab | |
| Status OA? | 3/10/2004 | 1/29/2004 | | Dominic | |
| | | | | M. Kotab | |
| Office Action 3 mos. | 7/13/2004 | 7/12/2004 | Yes | Dominic | |
| | | | | M. Kotab | |
| Status OA? | 7/29/2004 | 4/13/2004 | | Dominic | |
| | | | | M. Kotab | |
| Check PAIR | 8/12/2004 | 7/12/2004 | | Dominic | Confirmed - Confirm receipt of Amendment A |
| | | | | M. Kotab | |
| Office Action 6 mos. | 10/13/2004 | 7/12/2004 | | Dominic | |
| | | | | M. Kotab | |
| Status OA? | 10/13/2004 | | | Dominic | |
| | | | | M. Kotab | |
| → Restriction | 12/4/2004 | | | Dominic | If document had been received ← |
| | | | | M. Kotab | |
| Petition to Revive | 5/11/2005 | 5/11/2005 | | Dominic | Re-Docketed - Due to the restriction mailed 11/4/04 that we never received. |
| | | | | M. Kotab | |
| Petition to Revive | 5/18/2005 | 5/18/2005 | | Dominic | Re-Docketed- Date has passed- Due to the restriction mailed 11/4/04 that we never received. |
| | | | | M. Kotab | |
| Petition to Revive | 5/25/2005 | | | Dominic | Due to the restriction mailed 11/4/04 that we never received. |
| | | | | M. Kotab | |
| Petition to | 6/1/2005 | | | Dominic | Due to the restriction mailed 11/4/04 that |

Patent Case Print [ID 201]

Page 3 of 3

Revive
Petition to
Revive 6/8/2005

M. Kotab we never received.
Dominic Due to the restriction mailed 11/4/04 that
M. Kotab we never received.

Inventors

| Inventor | Custom Text #2 | Assignment Date | Inventor Date #2 | Inventor 1 | Inventor 2 | Real Number 1 | Real Number 2 |
|---------------------------|-------------------|--------------------|---------------------|---------------|---------------|------------------|------------------|
| Robert Glenn Biskeborn | | | | | | | |

Assignment

Assignment1 Reel/Frame Assignment Date
Assignment 012429/0241 1/3/2002

CreateUser: conv

CreateDate: 3/14/2003

Copyright 2002 by Master Data Center, Inc.

UpdateUser: Melissa

UpdateDate: 5/24/2005

Downloaded 5/24/2005 12:59:00 PM

PAIRConnect Patent Record

IBM1P008

| | | | | | |
|----------------------------------|------------|---|--|--|--|
| Office Action Mailed Date | 1/29/2004 | Requirement for Restriction / Election | | | |
| | 1/26/2004 | Date Forwarded to Examiner | | | |
| | 11/21/2003 | Response to Election / Restriction Filed | | | |
| | 11/19/2003 | | | | |
| Office Action 3 mos. | 11/19/2003 | Mail Restriction Requirement | | | |
| | 9/10/2003 | | | | |
| Status OA? | 9/10/2003 | | | | |
| Office Action Mailed Date | 9/10/2003 | Requirement for Restriction / Election | | | |
| | 9/8/2003 | | | | |
| Status Inquiry | 8/19/2003 | | | | |
| Status Inquiry | 8/5/2003 | | | | |
| Publication | 2/27/2003 | | | | |
| | 4/22/2002 | Case Docketed to Examiner in GAU | | | |
| Recorded Assignment Received | 2/28/2002 | | | | |
| | 1/17/2002 | Application Dispatched from OIPE | | | |
| | 1/10/2002 | Application Is Now Complete | | | |
| Filing Receipt | 1/10/2002 | | | | |
| Notice of missing parts - final | 11/21/2001 | | | | |
| Assignment | 11/21/2001 | Notice Mailed--Application Incomplete--Filing Date Assigned | | | |
| | 10/1/2001 | | | | |
| | 9/26/2001 | Correspondence Address Change | | | |
| Notice of missing parts mailed | 9/26/2001 | | | | |
| Filing Receipt | 9/26/2001 | | | | |
| | 9/26/2001 | Correspondence Address Change | | | |
| | 8/31/2001 | IFW Scan & PACR Auto Security Review | | | |
| Information Disclosure Statement | 8/30/2001 | | | | |
| | 8/23/2001 | Initial Exam Team nn | | | |